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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/808,778	03/24/2004	John Armstrong	EFIM0374	5911
31408 7590 11/09/2007 LAW OFFICE OF JAMES TROSINO 92 NATOMA STREET, SUITE 211 SAN FRANCISCO, CA 94105			EXAMINER PHILLIPS, HASSAN A	
			ART UNIT 2151	PAPER NUMBER
			MAIL DATE 11/09/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/808,778

Applicant(s)

ARMSTRONG ET AL.

Examiner

Hassan Phillips

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 March 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 March 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>See Continuation Sheet</u> . | 6) <input type="checkbox"/> Other: _____ |

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :10/16/07, 9/13/05, 7/5/05, 6/20/05, 3/24/04.

DETAILED ACTION

1. This action is in response to communications filed March 24, 2004.

Information Disclosure Statement

2. The information disclosure statements filed October 16, 2007, September 13, 2005, July 5, 2005, June 20, 2005, and March 24, 2004, have been received and considered by the examiner.

Drawings

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "16" in Fig.'s 7, 10, and 12 has been used to designate both "Directory Server" and "Client Hillary". In previous drawing Figures and in the specification (e.g. pg.18, line 33) applicant has identified the "Directory Server" as reference character "20". Reference character "18" in Fig.'s 7, 10, and 12, has been used to designate both a network and "Modem". In previous drawings applicant has identified the network as reference character "24". Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner,

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the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: second network "22" in Fig.'s 7, 10, and 12, (see at least pg. 18, line 13, pg. 21, line 32, and pg. 23, line 19). In previous drawings applicant has identified the second network "24" as reference character "22". Directory server "20" in Fig.'s 10 and 12, (see at least pg. 22, line 4, and pg. 23, line 25) are also not mentioned in the description. In previous drawings applicant has identified the Directory server "16" as reference character "20". Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

5. Claims 13, 14, 26 are objected to because of the following informalities: the claim language is unclear. Claims 13 and 26 similarly recite "the identifying information comprises **an address of the first network on the second network**". Examiner was unable to find a description for what applicant meant by an "address of the first network" in the disclosure. Instead it appears applicant meant to say "...an address of **the first network device** on the first network..." (e.g. see applicant's disclosure pg. 10, lines 1-17). Claim 14 recites "a query processor adapted to request **information regarding the first network** from the directory server". Once again examiner was unable to find a description for what applicant meant by "information regarding the first network". Instead it appears applicant meant to say "...information regarding **the network device coupled to the first network**..." (e.g. see applicant's disclosure pg. 11, lines 25-27). In order to advance prosecution, examiner has interpreted the claims as best understood in light of the specification. Appropriate correction is required.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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7. Claims 1, 2, 5, 7, 8, 11-15, 18, 20, 21, 24- 26, are rejected under 35 U.S.C. 102(b) as being anticipated by Spinks et al. (hereinafter Spinks), U.S. Patent Pub. No. 2001/0029534.

8. In considering claim 1, Spinks discloses a network device (74, 90, 92, 98) coupled to a first network (30) and to a directory server (84) (see Fig. 2), the network device comprising: information (100) identifying the network device on the first network, (pg. 5, par. [0068]); and a registration processor (88) adapted to provide the identifying information to register the network device on the directory server, (pg. 5, par. [0068]).

9. In considering claims 2 and 15, Spinks discloses the network device comprises one of a computer, personal digital assistant, pager, cellular telephone, handheld messaging device, facsimile machine, copier, printer, telephone, security camera, household appliance, vending machine, kiosk, or digital camera, (pg. 4, par.'s [0059], [0061]).

10. In considering claims 5 and 18, Spinks discloses the network device further comprises a network connection (26, 28) for coupling to the first network, (pg. 3, par. [0047]).

11. In considering claims 7 and 20, Spinks discloses the first network comprises a plurality of interconnected networks (30, 50), (pg. 4, par. [0060]).

12. In considering claims 8 and 21, Spinks discloses the first network is coupled to a second network (64) that comprises any of a wide area network, global network, public network, or the Internet, (pg. 4, par. [0058]).

13. In considering claims 11 and 24, Spinks discloses the identifying information comprises an address, (pg. 6, par. [0084]).

14. In considering claim 12, Spinks discloses the identifying information comprises an address of the network device on the first network, (pg. 6, par. [0084]).

15. In considering claims 13 and 26, Spinks discloses the first network is coupled to a second network (50) (pg. 4, par. [0060]), and the identifying information comprises an address of the first network on the second network, (pg. 6, par. [0084]).

16. In considering claim 14, Spinks discloses a network device (74, 90, 92, 98) coupled to a first network (30) and to a directory server (84) (see Fig. 2), the network device comprising: information (100) identifying the network device on the first network, (pg. 5, par. [0068]); and a query processor (166) adapted to request information regarding the first network from the directory server, (pg. 6, par. [0081]).

17. In considering claim 25, Spinks discloses the information comprises an address of a second network device on the first network, (pg. 6, par.'s [0081], [0084]).

Claim Rejections - 35 USC § 103

18. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

19. Claims 3, 6, 16, 19, are rejected under 35 U.S.C. 103(a) as being unpatentable over Spinks.

20. In considering claims 3 and 16, Spinks discloses the network device comprises a network printer (92) coupled to the first network and the directory server, (pg. 4, par. [0061], pg. 5, par. [0068], also see Fig. 2).

Although Spinks discloses substantial features of applicant's claimed invention, Spinks fails to expressly disclose: the network device comprises one of an inkjet printer, laser printer, wide format printer, or dot matrix printer.

Nevertheless, it was well known in the art that a network printer could comprise an inkjet printer, laser printer, wide format printer, or dot matrix printer.

Thus, if not implicit in the teachings of Spinks, it would have been obvious to one of ordinary skill in the art to modify the teachings of Spinks to expressly disclose the

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network device comprises one of an inkjet printer, laser printer, wide format printer, or dot matrix printer. As was known in the art, a printer such as a laser printer for example, would provide fast, high quality print outs for a user of the printer. Using such a printer in the teachings of Spinks would have allowed for the specific type of printer to register identifying information on the directory server so the printer may be found, in case the physical location of the printer changes for example, (Spinks, pg. 2, par.'s [0016]- [0018]).

21. In considering claims 6 and 19, Spinks discloses "any network 30, 50 may be part of, and connect to the Internet 64", (pg. 4, par. [0058]), and "a system 70 may be installed at a network site 72, which may be an office or building belonging to an organization or the like", (pg. 4, par. [0059]).

Although Spinks discloses substantial features of applicant's claimed invention, Spinks fails to expressly disclose: the first network comprises a local area network.

Nevertheless, local area networks were well known in the art at the time of the present invention for connecting personal computers, printers and other devices inside buildings or on campuses for example.

Thus, if not implicit in the teachings of Spinks, it would have been obvious to one of ordinary skill in the art to modify the teachings of Spinks to expressly disclose the first network comprises a local area network. As was known in the art, this would have advantageously provided a network that was personal and/or specifically used for a company or organization. Using such a network in the teachings of Spinks would have

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provided a device registration process that would allow for a device in a local area network to be found, in case the physical location of the device changes for example, (Spinks, pg. 2, par.'s [0016]- [0018]).

22. Claims 4, 17, are rejected under 35 U.S.C. 103(a) as being unpatentable over Spinks in view of Tamura, U.S. Patent Pub. No. 2004/0133678.

23. In considering claims 4 and 17, although Spinks discloses substantial features of applicant's claimed invention, Spinks fails to expressly disclose: the network device comprises an Internet protocol telephone.

Nevertheless, Internet protocol telephones were well known in the art at the time of the present invention. In analogous teachings, Tamura exemplifies this where in a description of the prior art Tamura indicates networking trends have expanded to Internet protocol telephones among other devices, (pg. 1, par. [0005]).

Thus, it would have been obvious to one of ordinary skill in the art to modify the teachings of Spinks to expressly disclose the network device comprises an Internet protocol telephone. This would have advantageously allowed for networking with more devices including the Internet protocol telephone, (Tamura, pg. 1, par. [0005]). This also would have allowed for finding the Internet protocol telephone, in case the physical location of the Internet protocol telephone changes for example, (Spinks, pg. 2, par.'s [0016]- [0018]).

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24. Claims 9, 10, 22, 23, are rejected under 35 U.S.C. 103(a) as being unpatentable over Spinks in view of Hall et al. (hereinafter Hall), U.S. Patent Pub. No. 2002/0133555.

25. In considering claims 9 and 22, although Spinks discloses substantial features of applicant's claimed invention, Spinks fails to expressly disclose: the network comprises a firewall, and the network device is located within the firewall.

Nevertheless, a network comprising a firewall with a network device located within the firewall was well known in the art at the time of the present invention. In analogous teachings, Hall exemplifies this where Hall teaches a first network (i.e. company network) comprises a firewall, and a network device (i.e. company device) is located within the wall, (pg. 3, par. [0031]).

Thus, it would have been obvious to one of ordinary skill in the art to modify the teachings of Spinks to expressly disclose the network comprises a firewall, and the network device is located within the firewall. As was known in the art this would have advantageously protected the network device by limiting access to the network device (Hall, pg. 3, par. [0031]).

26. In considering claims 10 and 23, although Spinks discloses substantial features of applicant's claimed invention, Spinks fails to expressly disclose: the network comprises a firewall, and the directory server is located outside the firewall.

Nevertheless, a network comprising a firewall with a directory server located outside the firewall was well known in the art at the time of the present invention. In analogous teachings, Hall exemplifies this where Hall teaches a first network (i.e. company network) comprises a firewall (pg. 3, par. [0031]), and a directory server located outside the firewall, (pg. 3, par. [0028]).

Thus, it would have been obvious to one of ordinary skill in the art to modify the teachings of Spinks to expressly disclose the network comprises a firewall, and the directory server is located outside the firewall. As was known in the art this would have advantageously protected the network device by limiting access to the network device, while still enabling the device to access the directory server through the firewall (Hall, pg. 3, par.'s [0029], [0031]).

Conclusion

27. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Franke et al. U.S. Patent 6,507,869 – discloses a method for tracking network attached devices (see abstract).

Nakamura, U.S. Patent 6,721,818 – discloses devices that store information on their location based on information obtained from a node (see abstract).

Page et al. U.S. Patent 7,024,476 – discloses directory enabled device management utilizing first and second communication protocols (see abstract).

28. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hassan Phillips whose telephone number is 571-272-3940. The examiner can normally be reached on Mon-Fri (8am-5pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on 571-272-3964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, appearing to read 'H. Phillips', with a stylized flourish at the end.

Hassan Phillips
11/7/07